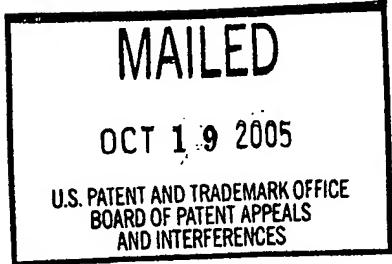


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte YEHOUDA HARPAZ



Appeal No. 2005-2318
Application No. 10/031,890

ON BRIEF

Before FRANKFORT, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 3 and 4, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to board games in which a move is done by indicating a point on the board (specification, p. 1). Claims 3 and 4 read as follows:

3. An electronic board comprising a grid of grid points on a flat surface, where each grid point is a visible element which is capable of detecting when it is pressed, and an illumination source inside or below the surface which is capable [of] illuminating the visible element by either of two colours;

which exhibits a behaviour which makes it useful for playing various games;

and in one of these games the behavior of the board is as follows:

the board keeps a record of the current player's colour, which is one of two colours above;

when a player presses a grid point, the board changes the illumination of a pattern of grid points around this grid point to the current player's colour if they were switched off, or reverses their colour if they were on, and then changes the record of the current player's colour to the other colour;

when all the grid points are switched on, the board declares as the winner the player of the colour of the majority of the grid points.

4. A board as described in claim 3, where the grid is square, and when a player presses an unilluminated grid point the board responds as follows:

points that are illuminated in the player's colour and are 1 point away from the pressed point on a line of the grid or a 45 degrees diagonal line become illuminated [in] the other player's colour. [sic, ;]

the pressed point and all the points that are unilluminated or are illuminated in the other player's colour and are 1 or 2 points away from the pressed point on a line of the grid or a 45 degrees diagonal line become illuminated in the player's colour.

Claim 4 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 3 and 4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,417,725¹ to Blumberg et al. (Blumberg).

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (mailed November 12, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed August 23, 2004) and reply briefs (filed November 30, 2004 and January 3, 2005) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art patent, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The written description rejection

We will not sustain the rejection of claim 4 under 35 U.S.C. § 112, first paragraph.

¹ Issued May 23, 1995.

The written description requirement serves "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him; how the specification accomplishes this is not material." In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). In order to meet the written description requirement, the appellant does not have to utilize any particular form of disclosure to describe the subject matter claimed, but "the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Put another way, "the applicant must . . . convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). The content of the drawings may also be considered in determining compliance with the written description requirement. Id., 935 F.2d at 1563-64, 19 USPQ2d at 1116-17 and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). Finally, "[p]recisely how close the original description must come to comply with the description requirement of section 112 must be determined on a case-by-case basis." Eiselstein v. Frank, 52 F.3d 1035, 1039, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (quoting Vas-Cath, 935 F.2d at 1561, 19 USPQ2d at 1116).

In our view, the appellant's written description of the game FillIt set forth on pages 7-8 of the specification and Figure 4 provides the necessary written description support that ensures that the inventor had possession, as of the application's filing date, of the subject matter of claim 4. The examiner's position (answer, pp. 5-6) that "[n]o where in the originally filed specification is there antecedent basis for '45 degrees diagonal line become illuminated'" is without merit. In that regard, antecedent basis for "45 degrees diagonal line become illuminated" is provided directly in Figure 4 (see patterns around points 16 and 18 and in the specification (the description of the game FillIt; pp. 7-8).

For the reasons set forth above, the decision of the examiner to reject claim 4 under 35 U.S.C. § 112, first paragraph, is reversed.

The anticipation rejection

We will not sustain the rejection of claims 3 and 4 under 35 U.S.C. § 102(b).

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between

the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

Blumberg's invention relates to puzzles and devices for implementing puzzles. Blumberg discloses a puzzle device, comprising: (a) an array of indicators, each of the indicators capable of alternately indicating a first state or a second state; (b) means for selecting one of the array of indicators; and (c) means for changing, upon the selection of the one of the array of indicators, the state of at least one of the other of the indicators based on a pre-determined pattern. According to Blumberg, the indicators are visual indicators, such as differently colored lights or lights which can be either on or off.

Figure 1 of Blumberg illustrates one possible form of a device for implementing a puzzle according to his invention. The device 10 includes an array of indicators 12 each of which is capable of alternately indicating a first state or a second state. The array of indicators 12 can be linear (one-dimensional) or three-dimensional, but is preferably two-dimensional, as illustrated in the drawings. The two-dimensional array may be planar, as shown in the Figures, or may be wrapped in three-dimensional space, for example to form the six sides of a cube or to form a substantially spherical

configuration. The two-dimensional array, which may be of any desired size, may be rectangular, but is preferably square. Square arrays of 4X4 or 5X5 are considered to be highly desirable for many applications. The device includes means for selecting one of indicators 12, which may involve touching or moving indicator 12 itself or an element which is suitably connected to indicator. Finally, the device further includes suitable display activating means which, upon the selection of one of indicators, change the state of at least one of the non-selected indicators, perhaps also changing the state of the selected indicator. The determination of which indicators change state upon the selection of one of the indicators is made based on a preset pattern or algorithm.

Examples of four of the many possible patterns are shown in Figures 1-4. In each of the figures it is assumed, for purposes of exposition, that the user selects the central indicator (element C3) of an array initially having all indicators 12 of the same state (blank). Figures 1-4 show the state of the array immediately after the selection of element C3. In Figure 1 five indicators change state, the selected indicator and the four indicators adjacent to the selected indicator along the diagonal (elements B2, B4, D2 and D4). In Figure 2 five indicators change state, the selected indicator and the four indicators adjacent to the selected element in the same row or column as the selected indicator (elements B3, C2, C4 and D3). In Figure 3 three indicators change state, the two indicators adjacent to the selected indicator to the left and above and the diagonal

indicator between the two other indicators (elements B2, B3 and C2). In Figure 4 three indicators change state, the selected indicator and the two indicators adjacent to the selected indicator on the diagonal above and to the left and below and to the right (elements B2 and D4).

Illustrated in Figures 5-8 is a sequence of three selections using the pattern of Figure 2. Figure 5 shows a typical starting position with some of indicators 12 being in one state while the rest are in a second state. When indicator C3 is selected (indicated by X in Figure 5) the result is the configuration of Figure 6. It is to be noted that indicators C3 as well as B3, C2, C4 and D3 have changed state. The next selection is indicator D3 (X in Figure 6). When D3 is selected the result is shown in Figure 7. It is to be noted that indicators D3 as well as C3, D2, D4 and E3 have changed state. Finally, when C5 is selected (X in Figure 7), the result is an array wherein all indicators 12 are of the same state, as shown in Figure 8. It is to be noted that indicators B5, C4, C5 and D5 have changed states while the fifth element of the pattern is beyond the edge of the 5X5 array and is thus not involved. It is noted that if the objective of the manipulation had been to get from the indicator configuration of Figure 5 to a situation wherein all indicators 12 are of the same state, then the objective would have been satisfied through the series of three moves described in Figure 5-8.

Clearly, the specific behaviour of the one game set forth in the last nine lines of claim 3 and all of claim 4 is not taught or suggested by Blumberg. To deal with this shortcoming of Blumberg, the examiner (answer, pp. 4-5) stated that:

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitation *Ex parte Masham*, 2 USPQ2d 1647 (1987). A recitation of the intended use of the claimed invention must result a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Thus, in the structural claim dictated by these claims [i.e., claims 3 and 4], the Blumberg et al. device is capable of being used to play a variety of games and programming the device to be used in a different manner would not result in a structural difference, only a difference of a software program executed by the processor. Hence the recitation that the device be employed to play a variety of games as well as an example of such a game does not differentiate the claimed apparatus from the Blumberg et al. apparatus which satisfies the claimed structural limitation.

In our view, claim 3 is drawn to a specifically programmed electronic board capable of being used to play a variety of games including the specific game set forth in the last nine lines of claim 3. Likewise, claim 4 is drawn to a specifically programmed electronic board capable of being used to play a variety of games including the specific game set forth in the last nine lines of claim 3 and all of claim 4.

While the Blumberg device is capable of being used to play a variety of games, the Blumberg device is not capable of playing the specific game set forth in the last nine lines of claim 3. In that regard, a computer or device programmed to play a specific game results in a structural difference over an unprogrammed general purpose computer or device.²

For the reasons set forth above, claim 3 is not anticipated by Blumberg. Accordingly, the decision of the examiner to reject claim 3, and claim 4 dependent thereon, under 35 U.S.C. § 102(b) is reversed.

² A general purpose computer, or microprocessor, programmed to carry out an algorithm creates "a new machine, because a general purpose computer in effect becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software." In re Alappat, 33 F.3d 1526, 1545, 31 USPQ2d 1545, 1558 (Fed. Cir. 1994) (en banc); see In re Bernhart, 417 F.2d 1395, 1399-1400, 163 USPQ 611, 615-16 (CCPA 1969) ("[I]f a machine is programmed in a certain new and unobvious way, it is physically different from the machine without that program; its memory elements are differently arranged.").

CONCLUSION

To summarize, the decision of the examiner to reject claim 4 under 35 U.S.C. § 112, first paragraph, is reversed and the decision of the examiner to reject claims 3 and 4 under 35 U.S.C. § 102(b) is reversed.

REVERSED

Charles E. Frankfort
CHARLES E. FRANKFORT
Administrative Patent Judge

Jeffrey V. Nase
JEFFREY V. NASE
Administrative Patent Judge

Jennifer D. Bahr
JENNIFER D. BAHR
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